

Appn. Number 09/473,078 (Shkedi) GAU 3622 Amnt. E contd.

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**REMARKS****I. Claims 42, 68, 77, and 78 - 35 USC 103 Rejection - Roth WO 98/34189 in view of Goldhaber # 5,794,210:**

Independent claims 42, 68, 77, and 78 define patentably over PCT Appl. # WO 98/34189 (Roth) in view of U.S. Pat. No. 5,794,210 (Goldhaber), because neither Roth nor Goldhaber disclose methods wherein the bid that is eventually selected was submitted *before* the visitor even visited the website. The claims also define over Roth and Goldhaber because neither reference discloses a method that "spreads" the attributes of an advertiser's bid/response to form a number of combinations of various attributes, and then "prices" each combination using the economic value contributions assigned to each attribute by the advertiser. The spreading and pricing steps also take place *before* the visitor even visits the website.

Further perspective follows:

**Roth**

- Roth discloses an auction system, where the visitor first visits the website, and then the visitor's profile is "put out for bid" to various advertisers. Roth describes his auction system on page 13 of his specification, lines 14-19: "View server 320 in turn sends information concerning the view-op to bidding agents 30. Bidding agents 30 in turn evaluate the characteristics of the view-op (which includes information supplied by server 320) against the criteria specified in each proposed bid. If the characteristics of a view-op meet the criteria in a proposed bid, a bidding agent 30 will submit a bid to view server 320." This is very different than the invention's claims, which distinctly define that advertisers pre-submit bids for various desired attributes, *before* the visitor has even visited the website.

While Roth does disclose that the advertisers' bidding agents obtain some limited information from advertisers before the visitor visits the website, this information does not form actual bids from which one bid is selected. Instead, in Roth the actual bids are only submitted to the website owner *after* the viewer profile is known and communicated to the advertiser or his bidding agent, as shown above.

- In addition, Roth does not disclose another key aspect of the invention defined in the claims - "spreading" the attributes of an advertiser's response to form a number of combinations of various attributes. This "spreading" step, done prior to the visitor's visit, is essential because it allows the later "selecting" step to be done in real-time. Without this step, sensible selection of a combination from an advertiser response is not viable in the economically critical real-time circumstances of Internet traffic banner placement and the like.

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### Goldhaber

- Like Roth, Goldhaber discloses an auction system, where the visitor first visits the website, and then the visitor's profile is "put out for bid" to various advertisers. This is very different than the invention's claims, which distinctly define that advertisers pre-submit bids for various desired attributes, *before* the visitor has even visited the website.
- Also like Roth, Goldhaber does not disclose another key aspect of the invention defined in the claims – "spreading" the attributes of an advertiser's response to form a number of combinations of various attributes. This "spreading" step, done prior to the visitor's visit, is essential because it allows the later "selecting" step to be done in real-time. Without this step, sensible selection of a combination from an advertiser response is not viable in the economically critical real-time circumstances of Internet traffic banner placement and the like.

Since neither Roth nor Goldhaber disclose the above-discussed features of the invention, which are clearly set forth in the claims, a combination of Roth and Goldhaber would also not disclose the features.

Further, even if a combination of Roth and Goldhaber disclosed all the features of the claims, it would not be obvious to modify Roth with Goldhaber, because doing so would significantly alter Roth's operating principles. Such a modification would not be obvious, as stated in MPEP 2143.01: "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F. 2d 810, 123 USPQ 349 (CCPA 1959)."

Finally, since independent claims 42, 68, 77, and 78 define patentably over a combination of Roth and Goldhaber, the dependent claims in the application define patentably as well.

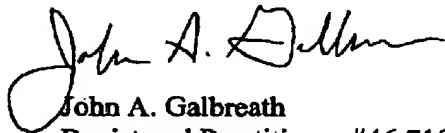
### CONCLUSION

For all of the above reasons, Applicant submits that the claims are now in proper form, and that the claims all define patentably over the prior art. Therefore Applicant submits that this application is now in condition for allowance, which action they respectfully solicit.

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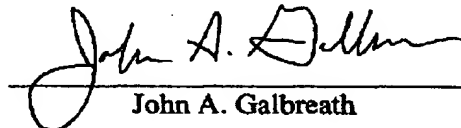
Very respectfully,



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**Certificate of Fax Transmission:** I certify that on the date below, this document and referenced attachments, if any, was faxed to the U.S. Patent Office at 703-872-9327.

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